

REMARKS

Introduction

In response to the final Office Action dated October 26, 2007, Applicants have amended claim 1. Claims 16-23 are withdrawn. Accordingly, claims 1-9, 13-15, 28, and 29 are pending. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that all pending claims are in condition for allowance.

Entry of Amendment under 37 C.F.R. § 1.116

Applicants request entry of this Rule 116 Response. Support for amended claim 1 is found in, for example, Paras. [0008] and [0050] and Fig 3. There are no new issues presented. As will be explained below, the claim amendments place the application in condition for allowance. Moreover, the Manual of Patent Examining Procedure sets forth in Section 714.12 that “any amendment that would place the case either in condition for allowance or in better form for appeal may be entered.” Entry of these claim amendments is respectfully requested.

Claim Rejection Under 35 U.S.C. § 112

The Office Action asserts that the limitation, “interior,” recited in claim 1 has insufficient antecedent basis. Claim 1 has been amended to recite, in part, “...said drilled hole substantially extending the length of the interior **of each primary plug** for transporting the stream of lubricant vapor.” According to the claimed subject matter per amended claim 1, each of the plugs includes a drilled hole that extends substantially the length of the plug’s interior (*see, e.g.*, Fig. 3 and pg. 9, lines 3-4).

Accordingly, one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed invention, particularly when reasonably interpreted in light of the supporting specification. Therefore, it is respectfully submitted that the imposed rejection under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicants solicit withdrawal thereof.

Double Patenting

Claims 1-8, 13-15, 28, and 29 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,613,151 (hereinafter the '151 Patent) in view of U.S. Patent No. 5,803,976 to Baxter et al. (hereinafter Baxter). Claim 9 stands rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of the '151 Patent in view of Baxter, in further view of U.S. Patent No. 5,904,958 to Dick et al. (hereinafter Dick).

Applicants respectfully request that the Examiner hold these rejections in abeyance until allowable subject matter is obtained in the present application.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-8, 13, 15, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Helling et al. (U.S. Pat. No. 5,882,415, hereinafter "Helling") in view of Baxter. Applicants traverse.

As a preliminary matter, the Examiner applies the teachings of Baxter to Stirniman on page 7 of the Office Action. The instant application is a Continuation-In-Part (CIP) of Stirniman. Thus, Stirniman does not qualify as a prior art reference under 35 U.S.C. § 102 or

103. Accordingly, the rejection of claims 1-8, 13, 15, 18, and 19 predicated on Stirniman should be withdrawn.

In order to expedite prosecution, Applicants will address the 35 U.S.C. § 103 rejection over Helling in view of Baxter.

Amended claim 1 recites, in part, "...at least one elongated lubricant vapor source comprising a closed heated chamber fluidly communicating with at least a plurality of primary plugs having an interior for supplying a stream of lubricant vapor, wherein each of said plurality of primary plugs comprises a drilled hole **and two openings**, said drilled hole substantially extending the length of the interior of each primary plug for transporting the stream of lubricant vapor."

The Office Action admits that Helling fails to teach a plurality of primary plugs. The Office Action relies on Baxter in an attempt to cure the deficiencies of Helling. The Office Action asserts that Baxter teaches an elongated vapor source 15 with plugs 37 including a drilled hole.

Turning to the cited reference, Baxter describes an evaporator 15 including a crucible 35 in which the material 36 to be deposited on the substrate 21 is contained and evaporated. The crucible 35 of Baxter is a closed vessel that is encased in a retort 37, as shown in Figs. 6 and 10. The crucible 35 of Baxter has one opening 29, not two openings. Thus, Baxter fails to disclose or suggest, "...at least one elongated lubricant vapor source comprising a closed heated chamber fluidly communicating with at least a plurality of primary plugs having an interior for supplying a stream of lubricant vapor, wherein each of said plurality of primary plugs comprises a drilled hole **and two openings**, said drilled hole substantially extending the length of the interior of each primary plug for transporting the stream of lubricant vapor," as recited in amended claim 1.

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). There is no suggestion in Helling to modify the crucible, nor does common sense dictate the Examiner-asserted modifications. The Examiner has not provided any evidence that there would be any obvious benefit in making the asserted modification of Helling. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

The only teaching of the plurality of primary plugs having an interior for supplying a stream of lubricant vapor, a drilled hole, and two openings is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Neither Helling nor Baxter, individually or combined, disclose or suggest, "...at least one elongated lubricant vapor source comprising a closed heated chamber fluidly communicating with at least a plurality of primary plugs having an interior for supplying a stream of lubricant vapor, wherein each of said plurality of primary plugs comprises a drilled hole **and two openings**, said drilled hole substantially extending the length of the interior of each primary plug for transporting the stream of lubricant vapor," as recited in amended claim 1.

Claims 1-8, 13-15, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hedgcoth (U.S. Patent No. 6,036,824) in view of Baxter.

The Office Action acknowledges that Hedgcoth fails to teach at least a plurality of primary plugs for supplying a stream of vapor.

The Office Action is *completely silent* on how Baxter cures the deficiencies of Hedgcoth. This rejection is not legally viable for at least this reason.

Even so, the crucible 35 of Baxter has one opening 29, not two openings. Baxter fails to disclose or suggest, "...at least one elongated lubricant vapor source comprising a closed heated chamber fluidly communicating with at least a plurality of primary plugs having an interior for supplying a stream of lubricant vapor, wherein each of said plurality of primary plugs comprises a drilled hole **and two openings**, said drilled hole substantially extending the length of the interior of each primary plug for transporting the stream of lubricant vapor," as recited in amended claim 1. Thus, Baxter does not cure the deficiencies of Hedgcoth.

Claim 9 stands rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Helling as modified by Baxter and Hedgcoth, and in further view of U.S. Patent No. 5,904,958 to Dick et al.

It is respectfully submitted that the Examiner has improperly rejected claim 9 on the grounds of nonstatutory obviousness-type double patenting. None of the references cited in this rejection share common inventors or assignees with the instant application.

Accordingly, withdrawal of the foregoing rejections is requested.


Conclusion

In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Lisa A. Kilday
Registration No. 56,210

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BKS:LAK
Facsimile: 202.756.8087
Date: January 25, 2008

**Please recognize our Customer No. 49745
as our correspondence address.**